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HEWLETT-PACKARD COMPANY
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EXAMINER

ROSEN, NICHOLAS D

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/825,583	Applicant(s) WEBB, BRETT M.	
	Examiner Nicholas D. Rosen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-20 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8

Claims 1, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, dated September 13 and 14, 1999, made of record by Applicant with the Declaration received August 22, 2005, in view of Oberndorf ("Glorified Search Engines"). As per claim 1, Mr. Webb's e-mail discloses a method of gift purchasing, comprising: tracking, at a gift reminder service provider, at least one gift idea and a related event data for a user; generating a reminder, based on an Internet search relating to the at least one gift idea that is initiated and performed by the gift reminder service provider, wherein the reminder includes, for at least one gift idea, at least one network link to a gift merchant web site identified in the internet search that sells a gift related to the respective at least one gift idea; and electronically notifying the user prior to the event date with the reminder from the gift reminder service provider. The e-mail does not expressly disclose that the gift merchant web site is independent from the gift reminder service

Art Unit: 3625

provider, but Oberndorf teaches a search of an entire database of websites, without restriction to dependent merchants (see especially paragraph beginning "While most of the larger shopping agents"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the gift merchant web site to be independent from the gift reminder service provider, as an obvious consequence of searching the Web.

As per claim 6, Webb's e-mail discloses delivering the reminder to the user as an electronic mail notification from the gift reminder service provider through (by implication) a user interface.

As per claim 7, Webb's e-mail discloses obtaining the at least one network link from an internet search initiated by the gift reminder service provider for gift merchant web sites that sell gifts related to the at least one gift idea.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care and Oberndorf as applied to claim 1 above, and further in view of the anonymous article "BroadVision Enables mykidsbenefit.com to Publish First-Ever Personalized Electronic Magazine," hereinafter "BroadVision." Robertson does not expressly disclose that the user will obtain, for each at least one gift idea, a listing of a plurality of network links to independent gift merchant web sites that sell gifts related to the respective at least one gift idea, but "BroadVision" teaches a virtual gift store with an event reminder service that provides gift suggestions and then connects the user to a plurality of merchant gift sites (paragraph beginning "Another integral component"). Hence, it would have been obvious to one of ordinary

Art Unit: 3625

skill in the art of electronic commerce at the time of applicant's invention for the user to obtain a listing of a plurality of independent merchant web sites that sell appropriate gifts, as recited, for the obvious advantage of aiding the user in finding at least one merchant with a suitable gift for sale at a suitable price, with the terms otherwise being to the user's satisfaction.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, Oberndorf, and "BroadVision" as applied to claim 4 above, and further in view of official notice. Webb's e-mail does not expressly disclose displaying at the gift reminder web site a listing of gifts with each respective gift including a price, a description, and a uniform resource locator address for the respective independent gift merchant site, but official notice is taken that electronic listings of products with each product having such corresponding information are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display such a listing of gifts, for the obvious advantage of aiding the user in readily finding and ordering a gift according to his desires.

Claims 2, 3, and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care and Oberndorf as applied to claim 1 above, and further in view of official notice. As per claim 2, Webb's e-mail discloses displaying the at least one gift idea, but does not expressly disclose displaying the related event date, but that is obvious from the whole concept of reminding users of upcoming events, the basis of Webb's idea. Hence, it would have

Art Unit: 3625

been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display the related event date, for the obvious advantage of reminding users of when they need to obtain gifts.

Webb's e-mail does not disclose displaying information on a web site of the gift reminder service provider (although the word "page" is suggestive, appearing to perhaps offer an alternative to e-mail), but official notice is taken that it is well known to display information on web sites. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display the gift idea and related event date on a web site of the gift reminder service provider, for the obvious advantage of making the information and network links readily available on a suitable platform for information and links.

As per claim 3, Webb's e-mail discloses providing the network link as a URL, apparently for the gift merchant web site, but does not expressly disclose supplying the reminder service through a gift reminder web site, although the references to prior art web sites may imply this. In any event, use of a web site is held to be obvious, as set forth in the rejection of claim 2 above.

As per claim 8, Webb's e-mail does not disclose delivering the reminder to the user as a pop-up window, but official notice is taken that pop-up windows are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to deliver the reminder to the user as a pop-up window as recited, for the obvious advantage of making the reminder

Art Unit: 3625

conveniently available to the user in a manner which would be likely to capture his attention.

Claims 1, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (U.S. Patent 6,609,106) in view of Oberndorf ("Glorified Search Engines"). As per claim 1, Robertson discloses a method of gift purchasing, comprising: tracking, at a gift reminder service provider, at least one gift idea and a related event date for a user (Abstract; column 14, line 55, through column 15, line 31); generating a reminder, and electronically notifying the user prior to the event date with the reminder from the gift reminder service provider (Abstract; column 14, line 55, through column 15, line 31). Robertson does not disclose generating the reminder based on an Internet search relating to the at least one gift idea that is initiated and performed by the gift reminder service provider, but not only are Internet searches well known, but Oberndorf teaches a search engine searching the Internet for retailers who sell a particular type of item, without explicit instruction from the potential purchaser other than selection of a desired item (especially the six paragraphs beginning from "Many online search engines"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate the reminder based on an Internet search relating to the at least one gift idea that is initiated and performed by the gift reminder service provider, for the obvious advantage of readily finding an appropriate merchant offering an appropriate gift item.

Art Unit: 3625

Robertson discloses at least one network link to a gift merchant web site that sells an appropriate gift, wherein the gift merchant web site is independent from the gift reminder service provider (column 2, lines 26-53; column 14, lines 15-31).

As per claim 6, Robertson discloses delivering the reminder to the user as an electronic mail notification from the gift reminder service provider through (by implication) a user interface (column 14, lines 15-31).

As per claim 7, Robertson discloses a network link, while the Internet search is held to be obvious based on the teaching of Oberndorf, as set forth above regarding claim 1.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson and Oberndorf as applied to claim 1 above, and further in view of Song (U.S. Patent 6,865,546). Robertson does not expressly disclose displaying the at least one gift idea *and* the related event date, although the "detailed information" on an HTML page of column 15, lines 15-31, should in context be read as comprising the gift idea (see Figure 7). Song additionally discloses providing reminders of the event date (column 4, lines 39-51). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display the related event date on a web site of the gift reminder service provider, for the stated advantage of better ensuring that important events are not forgotten.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson and Oberndorf as applied to claim 1 above, and further in view of the anonymous article "BroadVision Enables mykidsbenefit.com to Publish First-Ever

Art Unit: 3625

Personalized Electronic Magazine," hereinafter "BroadVision." Robertson does not expressly disclose that the user will obtain, for each at least one gift idea, a listing of a plurality of network links to independent gift merchant web sites that sell gifts related to the respective at least one gift idea, but "BroadVision" teaches a virtual gift store with an event reminder service that provides gift suggestions and then connects the user to a plurality of merchant gift sites (paragraph beginning "Another integral component"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the user to obtain a listing of a plurality of independent merchant web sites that sell appropriate gifts, as recited, for the obvious advantage of aiding the user in finding at least one merchant with a suitable gift for sale at a suitable price, with the terms otherwise being to the user's satisfaction.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson, Oberndorf, and "BroadVision" as applied to claim 4 above, and further in view of official notice. Robertson does not expressly disclose displaying at the gift reminder web site a listing of gifts with each respective gift including a price, a description, and a uniform resource locator address for the respective independent gift merchant site, but official notice is taken that electronic listings of products with each product having such corresponding information are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display such a listing of gifts, for the obvious advantage of aiding the user in readily finding and ordering a gift according to his desires.

Art Unit: 3625

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson and Oberndorf as applied to claim 1 above, and further in view of official notice. As per claim 3, Robertson does not expressly use the phrase "web site" in context, but does disclose an HTML page (column 15, lines 15-31), and official notice is taken that HTML pages are commonly on web sites; Robertson further does not disclose that link is provided as a uniform resource locator for the gift merchant web site, but does disclose that the user chooses the appropriate reseller and clicks on the provided link to be transferred to a site (column 15, lines 32-35), and official notice is taken that clickable links are commonly uniform resource locators. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use a web site and a URL as recited, for the obvious advantage of accomplishing Robertson's disclosed method by technology and features well known and widely available for accomplishing that kind of thing.

As per claim 8, Robertson does not disclose delivering the reminder to the user as a pop-up window, but official notice is taken that pop-up windows are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to deliver the reminder to the user as a pop-up window as recited, for the obvious advantage of making the reminder conveniently available to the user in a manner which would be likely to capture his attention.

Claims 9-14

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, dated September 13 and 14, 1999, made of record by Applicant with the Declaration received August 22, 2005, in view of Oberndorf ("Glorified Search Engines"). As per claim 9, Webb's e-mail discloses a computer-based gift purchasing system, comprising: a user interface of a purchaser including a mechanism for entering at least one gift idea and presumably a related event date, the date being implied by the disclosed ability of the system to send reminders at appropriate times; at least one network-based reminder service provider including: an identification mechanism including an internet search function to initiate and perform an internet search to identify at least one gift merchant web site selling a gift relating to the respective at least one gift idea; and a notification mechanism configured to generate a notification viewable on the user interface with the notification including at least one gift idea and the related event date, and the notification including at least one activatable network link to the identified at least one gift merchant web site; and (inherent from the ability of the disclosed system to function) a network communication link enabling communication between the user interface, the at least one network-based reminder service provider, and the gift merchant web site. The e-mail does not expressly disclose that the gift merchant web site is independent from the gift reminder service provider, but Oberndorf teaches a search of an entire database of websites, without restriction to dependent merchants (see especially paragraph beginning "While most of the larger shopping agents"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention for the gift merchant web site to be independent from the gift reminder service provider, as an obvious consequence of searching the Web.

As per claim 10, Webb's e-mail discloses an electronic mail message listing the at least one activatable network link.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, and Oberndorf, as applied to claim 9 above, and further in view of "BroadVision." As set forth above in the rejection of claim 4, "BroadVision" teaches connecting a user to a plurality of gift sites; claims 11 and 12 are rejected on the same basis as claim 4.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, Oberndorf, and "BroadVision" as applied to claim 12 above, and further in view of official notice. Claim 13 is essentially parallel to claim 5, and rejected on the same grounds.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, and Oberndorf, as applied to claim 9 above, and further in view of official notice. Webb's e-mail does not expressly disclose databases, but official notice is taken that databases are well known; hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the system to comprise a gift registry database and calendar system, for the obvious advantage of enabling the system to readily carry out its disclosed functions.

Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (U.S. Patent 6,609,106) in view of Oberndorf ("Glorified Search Engines") and Song (U.S. Patent 6,865,546). As per claim 9, Robertson discloses computer-based gift purchasing system, comprising: a user interface of a purchaser including a mechanism for entering at least one gift idea and a related event data (Figure 1; column 14, line 55, through column 15, line 31); at least one network-based reminder service provider including: a notification mechanism configured to generate a notification viewable on the user interface with the notification listing at least one gift idea, the notification including at least one activatable network link to a gift merchant web site (column 14, line 55, through column 15, line 35 [even if the e-mail does not comprise such an activatable link, it leads to an HTML page which can be considered a notification, and does]); and a network communication link enabling communication between the user interface, the reminder service provider, and the gift merchant web site (Figure 1; column 14, line 55, through column 15, line 35). Robertson does not disclose an Internet search function to initiate and perform an Internet search to identify at least one gift merchant web site selling a gift relating to the respective at least one gift idea wherein the gift merchant web site is independent from the at least one network-based reminder service provider, but not only are Internet searches well known, but Oberndorf teaches search engine searching the Internet for retailers who sell a particular type of item without explicit instruction from the potential purchaser other than selection of a desired item (especially the six paragraphs beginning from "Many online search engines"). Hence, it would have been obvious to one of ordinary skill in the art

Art Unit: 3625

of electronic commerce at the time of applicant's invention to include a mechanism including an Internet search function, as recited, for the obvious advantage of readily finding an appropriate merchant offering an appropriate gift item.

Robertson does not expressly disclose including the related event date, but Song additionally discloses providing reminders of the event date (column 4, lines 39-51). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display the related event date on a web site of the gift reminder service provider, for the stated advantage of better ensuring that important events are not forgotten.

As per claim 14, Robertson discloses a gift registry database of the gift reminder service provider; and an event data database and calendar system of the gift reminder service provider (column 12, lines 26-34; column 14, line 55, through column 15, line 14).

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson, Oberndorf, and Song as applied to claim 9 above, and further in view of "BroadVision." As set forth above in the rejection of claim 4, "BroadVision" teaches connecting a user to a plurality of gift sites; claims 11 and 12 are rejected on the same basis as claim 4.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson, Oberndorf, Song, and "BroadVision" as applied to claim 12 above, and further in view of official notice. Claim 13 is essentially parallel to claim 5, and rejected on similar grounds.

Claims 15-17

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, dated September 13 and 14, 1999, made of record by Applicant with the Declaration received August 22, 2005, in view of Oberndorf ("Glorified Search Engines"). As per claim 15, Webb's e-mail discloses a computer-based gift purchasing system, comprising a gift reminder service provider; a display window viewable on a user interface of a computing device (implied by the "reminder email/page"), the window listing at least one gift idea; and a message in the display window received from the gift reminder service provider at a point in time prior to the event date including a network link to at least one gift merchant web site selling gift related to the at least one gift idea, wherein the at least one gift merchant web site is identified via an internet search, relating to the at least one gift idea, that is initiated and performed by the gift reminder service provider. Webb's e-mail discloses displaying the at least one gift idea, but does not expressly disclose displaying the related event date; but that is obvious from the whole concept of reminding users of upcoming events, the basis of Webb's idea. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display the related event date, for the obvious advantage of reminding users of when they need to obtain gifts.

The e-mail does not expressly disclose that the gift merchant web site is independent from the gift reminder service provider, but Oberndorf teaches a search of an entire database of websites, without restriction to dependent merchants (see especially paragraph beginning "While most of the larger shopping agents"). Hence, it

Art Unit: 3625

would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the gift merchant web site to be independent from the gift reminder service provider, as an obvious consequence of searching the Web.

As per claim 16, Webb's email discloses an electronic mail message.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, and Oberndorf, as applied to claim 15 above, and further in view of official notice. Webb's email does not expressly disclose a text message, but official notice is taken that text messages are well known (e.g., e-mails generally contain text). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for Webb's "reminder email/page" to include a text message, for the obvious way of conveniently communicating information.

Insofar as Webb's e-mail is not explicit about the various items of data included in the message, official notice is taken that these data are well known, making their inclusion obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of aiding the user in readily finding and ordering a gift according to his desires.

Moreover, the particular information included in a text message is held to be non-functional descriptive material, which is not a basis for patentability.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (U.S. Patent 6,609,106) in view of Oberndorf ("Glorified Search

Art Unit: 3625

Engines") and Song (U.S. Patent 6,865,546). As per claim 15, claim 15 is held to be obvious for essentially the same reasons, and on the same citations, as claim 9, as set forth above.

As per claim 16, Robertson discloses an e-mail message (column 15, lines 15-17).

Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson, Oberndorf, and Song as applied to claim 15 above, and further in view of official notice. The uniform resource locator link of claim 17 is held to be obvious in view of official notice as set forth above with regard to claim 3; insofar as Robertson, Oberndorf, and Song are not explicit about the various items of data included in the message, official notice is taken that these data are well known, making their inclusion obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of aiding the user in readily finding and ordering a gift according to his desires.

Moreover, the particular information included in a text message is held to be non-functional descriptive material, which is not a basis for patentability.

Claim 18

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, dated September 13 and 14, 1999, made of record by Applicant with the Declaration received August 22, 2005, in view of Oberndorf ("Glorified Search Engines"). Webb's e-mail discloses a method of gift purchasing system, comprising: tracking gift ideas and related event

Art Unit: 3625

dates for a user; and notifying the user at a point in time prior to the event data with an electronic reminder from the gift reminder service provider with the reminder including a network link to a web site of the gift reminder service provider for doing business with a gift merchant web site selling an appropriate gift, the gift merchant web site independent of the gift reminder service provider. Webb's e-mail does not expressly disclose that the gift merchant web site is independent of the gift reminder service provider by having no prior established relationship with the gift reminder service provider, but Oberndorf teaches conducting a search in an entire database of Web sites, without restriction to dependent merchants having an established prior relationship to the gift reminder service provider/search engine provider (see especially paragraph beginning "While most of the larger shopping agents"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the gift merchant web site to be independent from the gift reminder service provider, as an obvious consequence of searching the Web for the best deal.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (U.S. Patent 6,609,106) in view of Oberndorf ("Glorified Search Engines") and official notice. Robertson discloses a method of gift purchasing, comprising: tracking gift ideas and related event dates for a user (Abstract; column 14, line 55, through column 15, line 31); and notifying the user at a point in time prior to the event data with an electronic reminder from the gift reminder service provider with the reminder including a network link to a web site of the gift reminder service provider for

Art Unit: 3625

doing business with a gift merchant web site selling an appropriate gift (Abstract; column 14, line 55, through column 15, line 43). Arguably, Robertson does not expressly disclose accessing at least one activatable link to the gift merchant *from the electronic mail reminder*, but official notice is taken that activatable links, and in particular, links in e-mail, are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include a network link for accessing at least one activatable link to the gift merchant, for the obvious advantage of enabling the user to easily connect to the desired or recommended merchant site.

Robertson does not disclose that the gift merchant web site has no prior established relationship with the gift reminder service provider, but does disclose enabling the user to search for an alternate merchant (column 15, lines 19-31). In general, although not in Robertson, a search can search merchants with no established relationship to a particular provider, just any merchants on the Web, as in Oberndorf (especially the six paragraphs beginning from "Many online search engines"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to access at least one activatable link to a gift merchant web site with no prior established relationship with the gift reminder service provider, for the obvious advantage of readily finding an appropriate merchant, e.g., the cheapest merchant, since Oberndorf teaches letting users comparison shop.

Claim 19

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, dated September 13 and 14, 1999, made of record by Applicant with the Declaration received August 22, 2005, in view of Oberndorf ("Glorified Search Engines"). Webb's e-mail discloses a method of gift purchasing, comprising: generating an electronic reminder notification, via a gift reminder service provider, of at least one related gift idea for a gift recipient; identifying the plurality of gift merchant web sites in an internet-based search relating to the at least one related gift idea initiated and performed by the gift reminder service provider; sending the electronic reminder notification to a user prior to the at least one event date, with the notification including a network link leading to access to a plurality of gift merchant sites; and identifying the plurality of gift merchant web sites in an internet-based search relating to the at least one related gift idea initiated and performed by the gift reminder service provider. Webb further discloses URL links which can be sent by e-mail, and it well known from the functioning of the Internet that clicking on URL links accesses the corresponding web sites independent of the site which provides the URL (e.g., in an e-mail); Webb does not expressly disclose receiving at the gift merchant web site a purchase request from the user for the at least one gift via user-activation of the network link to the gift merchant, but given that URL's are sent, the such purchase requests are obvious, to achieve the disclosed purpose of "giv[ing] the user an extremely convenient way to do some quick shopping with the included links."

Webb does not expressly disclose that each merchant is independent of the gift reminder service provider, but Oberndorf teaches conducting a search in an entire database of Web sites, without restriction to dependent merchants having an established prior relationship to the gift reminder service provider/search engine provider (see especially paragraph beginning "While most of the larger shopping agents"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for each gift merchant web site to be independent from the gift reminder service provider, as an obvious consequence of searching the Web for the best deal.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (U.S. Patent 6,609,106) in view of Oberndorf et al. ("Glorified Search Engines"), Song (U.S. Patent 6,865,546), "BroadVision," and official notice. Robertson discloses a method of gift purchasing, comprising: generating an electronic reminder notification, via a gift reminder service provider, of at least one related gift idea for a gift recipient; sending the electronic reminder notification to a user prior to the at least one event date, with the notification including a network link leading to access to a plurality of gift merchant sites (in that a user may choose the preferred reseller or an alternate reseller) (Abstract; column 14, line 55, through column 15, line 31). Robertson does not disclose identifying the plurality of gift merchant web sites in an internet-based search relating to the at least one related gift idea initiated and performed by the gift reminder service provider, but not only are Internet searches well known, but Oberndorf teaches

Art Unit: 3625

search engines searching the Internet for retailers who sell a particular type of item without explicit instruction from the potential purchaser other than selection of a desired item (especially the six paragraphs beginning from "Many online search engines"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to identify the merchant web sites based on an Internet search relating to the at least one gift idea that is initiated and performed by the gift reminder service provider, for the obvious advantage of readily finding an appropriate merchant offering an appropriate gift item.

Robertson does not expressly disclose a link to a plurality of gift merchant web sites, but "BroadVision" teaches connecting a user to a plurality of gift merchants (paragraph beginning "Another integral component"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the user to obtain a link to a plurality of independent merchant web sites that sell appropriate gifts, as recited, for the obvious advantage of aiding the user in finding at least one merchant with a suitable gift for sale at a suitable price, with the terms otherwise being to the user's satisfaction.

Robertson does not expressly disclose generating a notification including at least one event date, but Song discloses providing reminders of the event date (column 4, lines 39-51). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate notification the related event date, for the stated advantage of better ensuring that important events are not forgotten.

Art Unit: 3625

Robertson does not disclose accessing the gift merchant web sites directly from the notification independent of the gift reminder service provider, but official notice is taken that it is well known for e-mails to contain URL's by which web sites can be accessed directly. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to access the gift merchant web sites directly from the notification independent of the gift reminder service provider, for the obvious advantage of quickly connecting to the merchant websites.

Given the teaching of connecting the user to merchant sites (in "BroadVision"), receiving a purchase request from the user for the at least one gift via user-activation of the network link to the gift merchant web site is held to have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of enabling users to make their purchases, without which the connecting of "BroadVision" would appear rather pointless.

Claim 20

Claim is rejected under 35 U.S.C. 103(a) as being unpatentable over the e-mail exchange between Brett Webb and Yahoo! Customer Care, dated September 13 and 14, 1999, made of record by Applicant with the Declaration received August 22, 2005, in view of Oberndorf ("Glorified Search Engines"). Claim 20 is largely parallel to claim 1, and given a computer system performing the method of claim 1, appropriate instructions for causing it to do so are held to be obvious, as necessary to enable the computer to carry out its disclosed functions.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (U.S. Patent 6,609,106) in view of Oberndorf et al. ("Glorified Search Engines"). Claim 20 is largely parallel to claim 1, and given a computer system performing the method of claim 1, appropriate instructions for causing it to do so are held to be obvious, as necessary to enable the computer to carry out its disclosed functions.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Applicant's affidavit appears to establish priority to before the filing date of Onyshkevych et al. (U.S. Patent Application Publication 2002/0138170), formerly relied upon as a secondary reference, but the Oberndorf article, which has an earlier publication date, is now used a secondary reference in place of Onyshkevych. Furthermore, the exchange of e-mails between Mr. Webb (the Applicant) and Yahoo! Customer Care, made of record with Applicant's Declaration, appears to constitute prior art dating to more than a year before Applicant's filing date. There is a court ruling, "While distribution to government agencies and personnel alone may not constitute publication . . . distribution to commercial companies without restriction on use clearly does." *Garret Corp. v. United States*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970).

Examiner has also considered Applicant's argument that Robertson discloses a preferred reseller having an established relationship with the gift registry site, rather

Art Unit: 3625

than an independent merchant. As a description of Robertson, this is accurate, but it is not believed to make Applicant's claims non-obvious, given the teachings of secondary references like Oberndorf. Conducting an Internet search for merchants selling a desired item, with the merchants in many cases having no special relationship with the search engine site, is well known, and there is motivation to make the combination.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barth et al. (U.S. Patent Application Publication 2005/0234853) disclose a method and apparatus for a dynamic information connection engine (including searching for supported information). Carpenter et al. (U.S. Patent Application Publication 2005/0235319) disclose features for use with advanced set-top applications for interactive television systems.

The anonymous article, "E-Malls Eye Brisk Sales for Year-End," discloses search engines for finding year-end gifts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-272-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

October 27, 2005